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REMARKS

Claims 14-34 are currently pending in the subject application and are presently under consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein.

I. Rejection of Claims 21-24, 28, 29, and 31, 32 Under 35 U.S.C. § 103(a)

Claims 21-24, 28, 29, and 31, 32 stand rejected under 35 U.S.C. §103(a) as being obvious over Petteruti *et al.* (US Patent 5,335,170.) Withdrawal of this rejection is respectfully requested for at least the following reason.

Petteruti *et al.* does not teach or suggest applicants' claimed invention.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, *the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art and not based on the Applicant's disclosure. See In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).*

Independent claim 21 recites in part an arrangement where a bottom surface of a scanner's body rests on a user's hand. Accordingly, whenever an operator employs applicants' claimed hand held scanner, a portion of the *scanner's body* extends over the radial surface of the user's hand, *e.g.*, the hand's radial surface provides a support that facilitates weight distribution of the scanner during operation. Such aspects of applicants' claimed invention are not taught or suggested by Petteruti *et al.* Rather, Petteruti *et al.* addresses a *separate* master module *connectable* to a body of the scanning device- not a *bottom surface of the scanning device's body* resting on a user's hand during operation, as in applicants' claimed invention.

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Moreover, Petteruti *et al.* in part teaches away from *any* arrangement of a *bottom surface* resting on a *user's hand*. In particular, Petteruti *et al.* *explicitly* states "Note that either the laser scanning module 12 or the CCD scanning module 14 generally can be used as a stand alone scanner *without* the master module connected to it." (See col. 3, lines 45-50.) A prior art reference must be considered in its entirety including portions that would lead away from the claimed invention. *W.L. Gore & Associates Inc. v. Garlock Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). A novel feature of applicants' claimed scanner is that while employing it, bottom surface of the scanning device *rests* on a user's hand to facilitate proper weight distribution, and Petteruti *et al.* in part teaches away from such novel features of the subject claims.

Independent claim 21 further recites a handle that extends from a bottom surface of the body at the first distal end to increase a viewing angle of the display. As compared with conventional placement of the display, applicants' claimed invention positions the display closer to the operator, and increases a viewing angle formed by the plane of display surface and operator's line of sight. Such aspects of the claimed invention, as conceded by the Office Action, are not taught or suggested by Petteruti *et al.* Despite the lack of teaching or suggestion of applicants' claimed invention in the cited reference, the Office Action rejects the subject claims as being obvious. The rationale proffered to modify Petteruti *et al.* is to achieve benefits identified in applicants' specification, which overcome problems associated with conventional systems/methods. Applicants' representative respectfully submits that this is an unacceptable and improper basis for a rejection under 35 U.S.C. §103. In essence, the Examiner is basing the rejection on the assertion that it would have been obvious to do something not suggested in the art because so doing would provide advantages stated in applicants' specification. Such rationale has been condemned by the CAFC. *See Panduit Corp. v. Dennison Manufacturing Co.*, 1 USPQ2d 1593 (Fed. Cir. 1987).

In view of the at least above comments rejection of independent claim 21, and claims 22-24, 28, 29, 31, 32 dependent therefrom should be withdrawn.

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II. Rejection of Claims 14-17, 20, and 33, 34 Under 35 U.S.C. § 103(a)

Claims 14-17, 20, and 33, 34 stand rejected under 35 U.S.C. §103(a) as being obvious over Petteruti *et al.* in view of Tracy *et al.* (US Patent 5,979,757). Withdrawal of this rejection is respectfully requested for at least the following reason. Petteruti *et al.* and Tracy *et al.*, alone or in combination, do not teach or suggest applicants' claimed invention.

Independent claim 14 recites a handle that extends from a bottom surface of the body. Such extending handle positions the bottom surface of applicants' claimed scanner on a radial surface of a user's hand, and also provides for increased viewing angle of the display. Petteruti *et al.* does not teach or suggest such claimed features as noted above with respect to independent claim 21, and Tracy *et al.* does not make up for the aforementioned deficiencies of Petteruti *et al.*

In view of the at least above comments, it is respectfully submitted that rejection of independent claim 14, claims 15-17, 20 dependent therefrom, and claims 33, 34 that depend from independent claim 21 should be withdrawn.

III. Rejection of Claims 18, 19, 25-27, and 30 Under 35 U.S.C. § 103(a)

Claims 18, 19, 25-27, and 30 stand rejected under 35 U.S.C. §103(a) as being obvious over Petteruti *et al.* as modified by Tracy *et al.* as applied to claim 14, and further in view of Reynolds *et al.* (US Patent 5,828,052). Withdrawal of this rejection is respectfully requested for at least the following reason. Petteruti *et al.* as modified by Tracy *et al.* and Reynolds *et al.* alone or in combination, do not teach or suggest applicants' claimed invention.

Claims 18, 19, claims 25-27, 30 respectively depend from independent claims 14, 21 and Reynolds *et al.* does not make up for the aforementioned deficiencies of Petteruti *et al.*, alone or in combination with Tracy *et al.* Thus, this rejection should be withdrawn.

IV. Rejection of Claims 14, 18-20, 21 Under Judicially Created Doctrine of Double Patenting

Claims 14, 18-20 and claim 21 are respectively rejected under judicially created doctrine of obviousness-type double patenting over claims 1-5 of US Patent 5,979,770 in view of Tracy *et al.*, and claims 21-23 and 25-31 of US Patent 6,244,513. The Examiner has

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indicated that a terminal disclaimer in compliance with 37 C.F.R. §1.321(c) can overcome this rejection. Applicants' representative herein submits such terminal disclaimer, and withdrawal of this rejection is respectfully requested.

V. CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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